

### **REMARKS**

Claims 1-25 and 27-32 are currently pending in the subject application and are presently under consideration. Claims 1 and 23 have been amended as shown on pp. 2-8 of the Reply.

Applicants' representative thanks the Examiner for considering the remarks tendered by telephone on 29 September 2008 at 5 p.m. PST, regarding inclusion of "paid inclusion listings" in the elements of the independent claims and the 101 rejection of claims 21 and 31. It is hoped that the remarks will facilitate a more meaningful dialog during the prosecution of the pending application.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

#### **I. Rejection of Claims 1, 21, and 31 Under 35 U.S.C. §101**

Claims 1, 21, and 31 stand rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Claim 1 has been amended to include physical structure to more clearly indicate that the applicants are not seeking protection for software *per se*. The Examiner is respectfully requested to withdraw the 35 U.S.C. § 101 rejection of claim 1 in light of these clarifying amendments.

With regard to claims 21 and 31, applicants' representative respectfully disagrees with the Examiner's reading of the claims. Both of these claims clearly and explicitly demonstrate an interaction with the physical world based on an interaction with a user. More specifically, claim 21 explicitly states, "modifying at least a subset of the plurality of listings according to one or more paid inclusion customers selected enhancement options", demonstrating that the selection of specific enhancements by the customer results in the modification of the presentation of a listing. This direct interaction, *e.g.*, cause and effect relationship, between the customer's action and the resulting alteration of the listing is sufficient to clearly establish the claimed method as eligible subject matter. Similarly, claim 31 states, "reporting at least one of [X, Y, and Z] to respective paid inclusion customer", illustrating that meaningful interaction with the customer is effected and establishing the method as eligible subject matter. The Examiner is also respectfully requested to withdraw the 35 U.S.C. § 101 rejections of claims 21 and 31 where these method claims clearly interact with the physical world in a meaningful manner.

## **II. Rejection of Claims 1-2, 4, 7-12, 14-15, and 19-20 Under 35 U.S.C. §103(a)**

Claims 1-2, 4, 7-12, 14-15, and 19-20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez (US 2004/0059720 A1) in view of Wen (US 2001/0047297 A1). Applicants' representative respectfully traverses the rejection of claims 1, 2, 4, 7-12, 14, 15, and 19-20 under 35 USC § 103(a) as being unpatentable over Rodriguez in view of Wen.

Applicants' disclosed subject matter relates generally to, “visually enhancing **paid inclusion listings** to facilitate offering a clear and substantial value to **paid inclusion advertisers** while retaining ordering rights to keep listings relevant to users”, (*see* pg. 2, ln 14-18). More specifically, the applicants' disclosed subject matter allows enhancement of listings by **the paid inclusion advertisers**, which is in not limited to end user sorting and filtering. Value is added to paid inclusion list advertisement placement by allowing the advertiser to emphasize their advertisement listings (*e.g.*, listings of advertisements produced from, for example, a search engine, as compared to the advertisements themselves).

The invention of Rodriguez is generally directed to searching and sorting multimedia and other data. More specifically, Rodriguez allows searches that can be sorted and filtered based on **user** input. Rodriguez does not disclose, either expressly or inherently, any form of enhancement other than sorting and filtering by the **user**.

The invention of Wen is generally directed to enabling end users to create advertisements that can be marketed by an ad broker system (*see* Wen abstract). While Wen does discuss user friendly methods of creating advertisements, including selecting and incorporating numerous eye-catching characteristics within the advertisement, *Wen never raises or discloses any aspect of enhancing paid inclusion listings*. The difference between an advertisement and a ‘listing of a plurality of search results and/or advertisements’ (*e.g.*, the paid inclusion listing(s) is an element of the set of listed results) is an important distinction between Wen and the instant application.

The Examiner states that the applicant has “defined” a paid inclusion customer as an “advertiser”, applicants' representative STRONGLY disagrees. The specification, as filed, at the portion cited by the Examiner, merely states: “[a provider] can offer...enhancements to paid inclusion customers (hereinafter, referred to as “advertisers”) to affect the rendering of any paid inclusion listing...”, illustrating that the term advertiser can be used as a shorthand notation for the longer term paid inclusion customer as used in the present application, which in not reasonably interpreted to mean that all advertisers are paid inclusion customers. The Examiner

cannot, based on an improper reading of the specification, maintain that Wen's comments regarding advertiser search engine listing enhancements is the same thing as enhancement of paid inclusion listings given the substantial discussion provided in the application as filed differentiating standard search engine advertising from paid inclusion listings. As discussed at interview, affecting paid inclusion listings is an aspect of novelty. The applicants' representative has made every effort to clearly narrow the claims to illustrate this aspect and clarify that the disclosed subject matter differs from emphasis made to standard search engine advertising.

Further, the Examiner has stated that claims 1 and 15 merely state paid inclusion listings in the preamble which is not afforded patentable weight. Generally, the applicants' representative disagrees with the Examiner's position wherein it is clearly stated "paid inclusion customers" in the elements of the claims. As such, it would reasonably be understood that a paid inclusion customer is related to a paid inclusion listing and therefore the preamble helps to define the scope of the claim and would thus be afforded weight in determining patentability. However, in the interest of efficient prosecution of the application, applicants' representative further amends the claims to more clearly establish this "relationship" between a paid inclusion customer and a paid inclusion listing where it otherwise might not be obvious to one of skill in the art. Independent claims 1 and 15 now explicitly contain reference to paid inclusion listings in the body of the claim and are therefore patentably distinct from Rodriguez and Wen, either alone or in combination.

Thus, in regard to independent claims 1 and 15 of the subject application, Wen does not cure the deficiency of Rodriguez, as discussed *supra*, failing to teach or disclose paid inclusion listing enhancements (claim 1 as amended recites "a selection component that allows a **paid inclusion customer** to select one or more **enhancements related to a paid inclusion listing**"). Similar language is found in claim 15. Moreover, Wen fails to cure the deficiency of Rodriguez to teach or disclose enhancements to the listings being selectively enhanced by the paid inclusion customer/advertiser. Essentially, Rodriguez teaches user sorting and filtering and Wen teaches a low technical and resource bar to creating advertisements, but neither teaches 'paid inclusion listing', nor enhancement of a 'paid inclusion listing', nor enhancement of the listing being within the purview of the party paying for the 'paid inclusion listing'. Clearly, the disclosed subject matter is entirely distinguishable from Rodriguez in view of Wen. Additionally, for the same reasons, Applicants submit that claims 2, 4, 7-12 and 14 are allowable, as these claims

depend from claim 1; and claim 19 is allowable, as this claim depends from claim 15. Claim 26 has been canceled and the rejection is obviated. Therefore, based on the above remarks, the applicants' representative respectfully requests that the Examiner withdraw the rejection of claims 1, 2, 4, 7-12, 14, 15, and 19-20 under 35 USC § 103(a) as being anticipated by Rodriguez in view of Wen.

Additionally, the Examiner has rejected claim 9 in light of "Official Notice". Where the Examiner contends that it would be obvious to isolate enhancement influence from search relevancy to keep the search targeted to the user's search criteria as related to paid inclusion listing advertisements, the applicants' representative requests that the Examiner produce a reference illustrating this point of official notice or withdraw the rejection as failing to particularly point out how the claimed subject matter is obviated.

Again, the Examiner has rejected claim 10 in light of "Official Notice". Where the Examiner contends that it would be obvious to differentiate enhanced paid inclusion listings from non-enhanced listings, the applicants' representative requests that the Examiner produce a reference illustrating this point of official notice or withdraw the rejection as failing to particularly point out how the claimed subject matter is obviated.

Moreover, the Examiner has rejected claim 15 in light of "Official Notice". Where the Examiner contends that it would be obvious to balance advertiser selections with user preferences to satisfy both advertiser and user requirements as it pertains to paid inclusion listings, the applicants' representative requests that the Examiner produce a reference illustrating this point of official notice or withdraw the rejection as failing to particularly point out how the claimed subject matter is obviated. Similar arguments apply to claim 17, 18, 25, 28,

Yet again, the Examiner has rejected claim 20 in light of "Official Notice". Where the Examiner contends that it would be obvious to generate a plurality of parallel listings with subsets having different enhancements with regard to paid inclusion listings, the applicants' representative requests that the Examiner produce a reference illustrating this point of official notice or withdraw the rejection as failing to particularly point out how the claimed subject matter is obviated. Similar arguments apply to claim 23, 24.

**III. Rejection of Claims 3, 5, 13, and 16-18 Under 35 U.S.C. §103(a)**

Claims 3, 5, 13, and 16-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez (US 2004/0059720 A1) and Wen (US 2001/0047297 A1) as applied to claims 1 and 15, and further in view of Petropolous et al. (US 7,042,502 B2). Applicants respectfully disagree for at least the following reason. Independent claim 1, from which claims 3, 5 and 13 depend, and independent claim 15, from which claims 16-18 depend, are believed to be allowable over Rodriguez in view of Wen, as asserted *supra*. Petropoulos does not correct this particular deficiency. The rejection of dependant claims 3, 5, 13 and 16-18 under 35 U.S.C. §103(a) is obviated and the Applicants respectfully request that the Examiner withdraw the rejection of claims 3, 5, 13 and 16-18 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Wen, in further view of Petropoulos.

**IV. Rejection of Claim 6 Under 35 U.S.C. §103(a)**

Claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez (US 2004/0059720 A1) and Wen (US 2001/0047297 A1) as applied to claim 4, and further in view of Vijayan et al. (US 6,535,888 B1). Applicants respectfully disagree for at least the following reason. Independent claim 1, from which claim 4 and thus claim 6 depends, is believed to be allowable over Rodriguez in view of Wen, as asserted *supra*. Vijayan does not correct this specific deficiency. The rejection of dependant claim 6 is obviated and the Applicants respectfully request that the Examiner withdraw the rejection of claim 6 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Wen, in further view of Vijayan.

**V. Rejection of Claims 21, 23-25, and 28 Under 35 U.S.C. §103(a)**

Claims 21, 23-25, and 28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez (US 2004/0059720 A1); Harik (US 2004/0267725 A1) and Wen (US 2001/0047297 A1). Applicants respectfully disagree for at least the following reason. Independent claim 21 is believed to be allowable over Rodriguez and Wen as disclosed *supra*. Harik does not cure this deficiency. Thus, where claim 21 is believed to be allowable, claims 23-25 and 28 are allowable as these claims depend from an allowable claim. The rejection of dependant claims 21, 23-25 and 28 under 35 U.S.C. §103(a) is obviated and the Applicants

respectfully request that the Examiner withdraw the rejection of claims 21, 23-25 and 28 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Harik, in further view of Wen.

**VI. Rejection of Claims 22 and 30 Under 35 U.S.C. §103(a)**

Claims 22 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez (US 2004/0059720 A1); Harik (US 2004/0267725 A1) and Wen (US 2001/0047297 A1) as applied to claim 21, and further in view of Petropolous et al. (US 7,042,502 B2). Applicants respectfully disagree for at least the following reason. Independent claim 21, from which claims 22 and 30 depend is believed to be allowable over Rodriguez, as asserted *supra*. Neither Harik, Wen, nor Petropolous, either alone or in combination, correct this deficiency. The rejection of dependant claims 22 and 30 under 35 U.S.C. §103(a) is obviated and the Applicants respectfully request that the Examiner withdraw the rejection of claims 22 and 30 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Harik, in further view of Wen, in still further view of Petropolous.

**VII. Rejection of Claim 27 Under 35 U.S.C. §103(a)**

Claim 27 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez (US 2004/0059720 A1); Harik (US 2004/0267725 A1) and Wen (US 2001/0047297 A1) as applied to claim 21, and further in view of Johnson (US 2002/0107847 A1). Applicants respectfully disagree for at least the following reason. Independent claim 21 is believed to be allowable over Rodriguez, Harik and Wen as disclosed *supra*. Johnson does not cure this deficiency. Thus, where claim 21 is believed to be allowable, claim 27 is allowable as depending from an allowable claim. Applicants respectfully request that the Examiner withdraw the rejection of claim 27 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Harik, in further view of Wen, in still further view of Johnson.

**VIII. Rejection of Claim 29 Under 35 U.S.C. §103(a)**

Claim 29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez (US 2004/0059720 A1); Harik (US 2004/0267725 A1) and Wen (US 2001/0047297 A1) as applied to claim 21, and further in view of Shultz et al. (US 2003/0061211 A1). Applicants respectfully disagree for at least the following reason. Independent claim 21, from which claim

29 depends is believed to be allowable over Rodriguez in view of Harik, in further view of Wen, as asserted *supra*. Shultz does not correct this deficiency. The rejection of dependant claim 29 is obviated and the Applicants respectfully request that the Examiner withdraw the rejection under 35 USC § 103(a) as being obvious over Rodriguez, in view of Harik, in further view of Wen, in still further view of Shultz.

**IX. Rejection of Claims 31 and 32 Under 35 U.S.C. §103(a)**

Claims 31 and 32 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Rodriguez (US 2004/0059720 A1) in view of Petropolous et al. (US 7,042,502 B2). Applicants respectfully disagree for at least the following reason. Applicants respectfully disagree for at least the following reason. Independent claim 31 is believed to be allowable over Rodriguez as disclosed *supra*. Petropolous does not cure this deficiency. Thus, where claim 31 is believed to be allowable, claim 32 is also allowable as depending from an allowable claim. Applicants respectfully request that the Examiner withdraw the rejection of claims 31 and 32 under 35 USC § 103(a) as being obvious over Rodriguez, in view of Petropolous.

**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP514US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

AMIN, TUROCY & CALVIN, LLP

/Himanshu S. Amin/

Himanshu S. Amin

Reg. No. 40,894

AMIN, TUROCY & CALVIN, LLP  
127 Public Square  
57<sup>th</sup> Floor, Key Tower  
Cleveland, Ohio 44114  
Telephone (216) 696-8730  
Facsimile (216) 696-8731